Supreme Court, U.S.
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No. 98-1719

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

THOMSON S.A.,

Petitioner,

—v.—

QUIXOTE CORPORATION AND DISC MANUFACTURING, INC.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITIONER'S SUPPLEMENTAL BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioner's statement pursuant to Rule 29.6 may be found in its Petition for Writ of Certiorari.

PETITIONER'S SUPPLEMENTAL BRIEF

Pursuant to Rule 15.8, petitioner submits this Supplemental Brief to call the Court's attention to a new Federal Circuit case which demonstrates why this petition should be granted. On June 9, 1999, the Federal Circuit rendered yet another conflicting decision on the important corroboration rule in the U.S. first to invent patent system. *Finnigan Corp. v. International Trade Commission*, ____F.3d ____, 1999 W.L. 374081.

Prior to the decision below in this case and prior to the *Finnigan* decision, the Federal Circuit upheld the corroboration rule for third party witnesses, including at least one witness who was not an inventor and had no interest in the outcome of the patent dispute there at issue. *Woodland Trust v. Flower Tree Nursery, Inc.*, 148 F.3d 1368 (Fed. Cir. 1998).

Next, in the decision below, the Federal Circuit overturned the corroboration rule for third party witnesses, unless they were inventors directly interested in the outcome of the case, *vis.*

> We, therefore, hold that corroboration is required only when the testifying inventor is asserting a claim of derivation or priority of his or her invention and is a named party, an employee or assignor to a named party, or otherwise is in the position where he or she stands to directly and substantially gain by his or her invention being found to have priority over the patent claims at issue.

(Pet. 12a).

Now, in *Finnigan*, the Federal Circuit has reversed itself again, holding that the corroboration rule does apply to third party witnesses, whether or not they are inventors and whether or not they are interested in the outcome. The Court now holds:

> Uninterested witnesses are also subject to the corroboration requirement.

1999 W.L. 374081, *11. The Court further explains:

> It is not surprising that the cases have held that testimony concerning a witness's own participatory activities must be corroborated. A witness who testifies to antedating the invention of the patent in suit can be expected to derive a sense of professional or personal accomplishment in being the first in the field, and in this sense is not uninterested in the outcome of the litigation, even if that witness is not claiming entitlement to a patent.

(Id.)

In addition to the injustice of changing the rules for different patentees, the question of whether and when the corroboration rule applies to third party witnesses is now completely confused.[1]

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[1] The *Finnigan* court purported to distinguish the case below, citing a district court statement that evidence of anticipation came from a variety of sources and characterizing the decision below as relating only to the sufficiency of corroboration. 1999 W.L. 374081, *12. There is no way this

If the Federal Circuit's decision below is allowed to stand, courts will be faced with the impossible task of applying now three conflicting decisions from the Federal Circuit (*Thomson, Woodland Trust* and *Finnigan*) regarding the corroboration rule.

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distinction can be squared with the facts or the decision below, however. As explained in the petition (Pet. 8-11), none of the allegedly corroborating evidence offered by defendants or referred to by the district court relates to the crucial issue of whether the prototype disc tested in June 1972 -- the only invalidating activity alleged to have occurred before petitioner's priority date -- contained each of the elements of the patent claims in suit. On this issue, defendants have only the uncorroborated testimony of one witness. The Federal Circuit's decision below was based on its conclusion that the corroboration rule did not apply to that witness, not on any analysis of the sufficiency of corroborating evidence.

CONCLUSION

For the foregoing reasons, the petition for a writ of *certiorari* should be granted.

Respectfully submitted,

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